

This Page Is Inserted by IFW Operations  
and is not a part of the Official Record

## **BEST AVAILABLE IMAGES**

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images may include (but are not limited to):

- BLACK BORDERS
- TEXT CUT OFF AT TOP, BOTTOM OR SIDES
- FADED TEXT
- ILLEGIBLE TEXT
- SKEWED/SLANTED IMAGES
- COLORED PHOTOS
- BLACK OR VERY BLACK AND WHITE DARK PHOTOS
- GRAY SCALE DOCUMENTS

**IMAGES ARE BEST AVAILABLE COPY.**

**As rescanning documents *will not* correct images,  
please do not report the images to the  
Image Problem Mailbox.**



10/697,907

Certificate of Transmission Under 37 C.F.R. §1.10

Express Mail Label EV 189444221 US

Date of Deposit: April 30, 2004

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to the Commissioner of Patents and Trademarks, Mail Stop Missing Parts, P.O. Box 1450, Alexandria, VA 22313-1450.

Rhonda Dunn  
Rhonda Dunn

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

**In re application of:** Caplan, et al.

**Docket No.:** ISAA0025

**Serial No:** 10/697,907

**Art Unit:** 2123

**Filed:** October 29, 2003

**Examiner:** Unknown

**Title:** Method and Apparatus for Creating and Evaluating Strategies

April 30, 2004

Commissioner for Patents

PO Box 1450

Alexandria VA 22313-1450

### **PROOF OF REFUSAL TO JOIN BY INVENTOR (37 C.F.R. 1.47)**

Applicant submits herewith the following statement as proof of refusal to join on part of named inventor Gary Sullivan.

1. My name is Rhonda Dunn and I am a patent administrator at Glenn Patent Group, attorney's for applicant.
2. Attached hereto is Exhibit A a copy of an email which was sent to inventor Gary Sullivan on 5 March 2004, and to which was attached a complete copy of the application papers, comprising the specification, claims, drawings, and the oath and declaration.

05/05/2004 YPOLITE1 00000044 071445 10697907

03 FC:1460

130.00 DA

3. As seen in Exhibit A, the inventor was provided with an opportunity to review the application. The inventor was contacted by email at his last known address. The email was not returned as undeliverable.

4. Attached as seen in Exhibit B, is a copy of an email which I sent the inventor, Gary Sullivan, on 18 March 2004. In this email I enclosed another copy of the application and other documents as described above and indicated to Mr. Sullivan that his continued lack of response would indicate his refusal to cooperate in completing the application papers.

5. I attach hereto as Exhibit C is an email, which I received from Gary Sullivan dated 21 March 2004, asking for further information. This indicates that the address at which Mr. Sullivan was contacted was indeed a current address, and that Mr. Sullivan was aware of our efforts to obtain his signature on these documents.

6. I attached here, to as Exhibit D, a copy of an email which I sent to Mr. Sullivan on 22 March 2004, again providing to Mr. Sullivan all documents associated with this application.

7. I attach hereto a copy of an email I sent to Mr. Sullivan on 7 April 2004, again presenting to Mr. Sullivan a copy of the documents associated with the present application, as mentioned above.

8. I attach hereto, as Exhibit F, a copy of an email I sent to Mr. Sullivan on 28 April 2004, again including all documents associated with present application.

9. I attach hereto, as Exhibit G, a log summarizing attempts made by Julie Thomas, an agent at this firm to reach Mr. Sullivan by telephone. While I have no personal knowledge of these phone calls, I include as part of this Exhibit emails to me from Julie Thomas, which are provided, as evidence of efforts to reach Mr. Sullivan. These include an email I received from Ms. Thomas on 8 April 2004, indicating that Ms. Thomas had talked to Mr. Sullivan but that he would call her back. Further included is an email I received from Ms. Thomas on 15 April 2004, indicating that Ms. Thomas called Mr. Sullivan once again. I further include an email I received from Ms. Thomas on 20 April 2004, indicating that Ms. Thomas had called Mr. Sullivan twice and had spoke to Mr. Sullivan personally on one of these occasions.

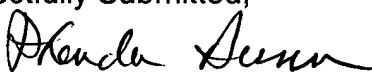
10. In view of my repeated efforts to obtain Mr. Sullivan's review of the patent documents for this application, and further in view of Mr. Sullivan's confirmation that he had indeed received at least some of the documents, and in view of our further efforts in a course of several weeks to provide the documents to Mr. Sullivan, all without his response, and further in view of Mr. Sullivan's understanding the need to respond within a particular period of time to avoid a loss of rights on the part of applicant, it is clear that applicant has made a *bona fide* attempt to present a copy of the application papers to a non-signing inventor for signature. It is clear from the course of communications that the inventor has refused to cooperate in reviewing and completing these documents. Accordingly, applicant has met its obligation under 37 C.F.R. 1.47.

The statements I make herein, accept as noted otherwise, are made on the basis of my direct knowledge, and are true, and that all statements made on information and belief are believed to be true; and further that these statements are made with the knowledge that willful false statements, and the like so made, are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application, any patent issuing thereon, or any patent to which this statement is directed.

This action is necessary to prevent irreparable damage and to preserve the rights of the parties.

The Commissioner is authorized to charge the petition fee forth in 37 C.F.R. 1.17 (i), and any additional fees that may be due and credit any overpayments to Deposit Account No. 07-1445 (Order No. ISAA0025).

Respectfully Submitted,

  
Rhonda Dunn

Patent Administrator, Glenn Patent Group

Customer No. 22,862

**Subject:** ISAA0025 Fair Isaac Patent Application

**Date:** Fri, 05 Mar 2004 11:49:50 -0800

**From:** Rhonda Dunn <rhonda@glenn-law.com>

**To:** Csullivan4000@aol.com

**CC:** jenniferhopper@fairisaac.com

**BCC:** Rhonda <rhonda@glenn-law.com>



## EXHIBIT A

**References:** 1

Dear Gary,

I am contacting you regarding a Fair Isaac Corporation patent application entitled "Method and Apparatus for Creating and Evaluating Strategies" in which you are a named inventor. Attached for your review is a copy of the application as filed. Please contact me if you feel you did not contribute to the conception of this invention.

Also attached are the Assignment and Declaration forms which require your signature. Please date, sign and return to me by March 20, 2004. The U.S. Patent Office requires that all inventors sign these forms.

Thank you, and please contact me if you have any questions.


Sincerely,


Rhonda


Rhonda Dunn  
Patent Administrator

Glenn Patent Group  
3475 Edison Way, Suite L  
Menlo Park, CA 94025  
650-474-8400 (Tel)  
650-474-8401 (Fax)  
Rhonda@glenn-law.com

This message is intended only for the individual to whom it is addressed and may contain information that is confidential, privileged, or otherwise exempt from disclosure under applicable law. If you are not the individual to whom this message is addressed, you are advised that any use, copying, or disclosure of this message or the contents thereof is without permission and contrary to law. If you receive this message in error, please call 650-474-8400.

 Assignment.doc	<b>Name:</b> Assignment.doc <b>Type:</b> Microsoft Word Document (application/msword) <b>Encoding:</b> base64 <b>Description:</b> Unknown Document <b>Download Status:</b> Not downloaded with message
--	--

 Dec:POA.doc	<b>Name:</b> Dec:POA.doc <b>Type:</b> Microsoft Word Document (application/msword) <b>Encoding:</b> base64 <b>Description:</b> Unknown Document <b>Download Status:</b> Not downloaded with message
---	---

 Pat. Appl. final 10.24.03.doc	<b>Name:</b> Pat. Appl. final 10.24.03.doc <b>Type:</b> Microsoft Word Document (application/msword) <b>Encoding:</b> base64 <b>Description:</b> Unknown Document <b>Download Status:</b> Not downloaded with message
---	---

**Subject:** ISAA0025 Fair Isaac Patent Forms

**Date:** Thu, 18 Mar 2004 14:05:34 -0800

**From:** Rhonda Dunn <rhonda@glenn-law.com>

**To:** Gsullivan4000@aol.com

**CC:** jenniferhopper@fairisaac.com, Rhonda <rhonda@glenn-law.com>

**BCC:** Julie Thomas <julie@glenn-law.com>

**References:** 1, 2



EXHIBIT B

Dear Gary,

I have not received your signature documents. I am again attaching the forms. Please sign, date and return them to me by March 24, 2004. The U.S. Patent Office requires all inventors to sign the declaration stating that they contributed to the claimed invention. The Assignment is a document which conveys ownership of the invention to Fair Isaac Corporation.

If we do not receive these forms back from you by March 24, 2004, we have no choice but to assume that you refuse to cooperate.

Please do not hesitate to call or email me if you have any questions.

I look forward to hearing from you soon,

Very truly yours,


Rhonda


--

Rhonda Dunn  
Patent Administrator

Glenn Patent Group  
3475 Edison Way, Suite L  
Menlo Park, CA 94025  
650-474-8400 (Tel)  
650-474-8401 (Fax)  
Rhonda@glenn-law.com

This message is intended only for the individual to whom it is addressed and may contain information that is confidential, privileged, or otherwise exempt from disclosure under applicable law. If you are not the individual to whom this message is addressed, you are advised that any use, copying, or disclosure of this message or the contents thereof is without permission and contrary to law. If you receive this message in error, please call 650-474-8400.

 Assignment.doc	<b>Name:</b> Assignment.doc <b>Type:</b> Microsoft Word Document (application/msword) <b>Encoding:</b> base64 <b>Description:</b> Unknown Document <b>Download Status:</b> Not downloaded with message
--	--

 Dec:POA.doc	<b>Name:</b> Dec:POA.doc <b>Type:</b> Microsoft Word Document (application/msword) <b>Encoding:</b> base64 <b>Description:</b> Unknown Document <b>Download Status:</b> Not downloaded with message
---	---

**Subject:** Re: ISAA0025 Fair Isaac Patent Forms

**Date:** Sun, 21 Mar 2004 20:27:05 EST

**From:** [Gsullivan4000@aol.com](mailto:Gsullivan4000@aol.com)

**To:** [rhonda@glenn-law.com](mailto:rhonda@glenn-law.com)

**CC:** [jenniferhopper@fairisaac.com](mailto:jenniferhopper@fairisaac.com), [Gsullivan4000@aol.com](mailto:Gsullivan4000@aol.com)

*Email from Gary*  
EXHIBIT C

Rhonda Dunn,

On February 27th I sent you email asking for more information with regards to the invention: Method and Apparatus for Creating and Evaluating Strategies. In that email I wrote that the title was too vague for me to relate that to any particular work at Fair Isaac.

I still have not heard any more information from you on this matter. You did forward to me two documents: the Assignment and the Declaration for Patent Application, but neither of these documents clarifies the nature of the invention.

I hope you can appreciate that before signing these documents I need to have a clear understanding of what is included under "Method and Apparatus for Creating and Evaluating Strategies". Please send me whatever supporting documentation that you can so that I can respond in time for your deadlines.

Regards,  
Gary Sullivan



**Subject:** Re: ISAA0025 Fair Isaac Patent Forms

**Date:** Mon, 22 Mar 2004 09:15:16 -0800

**From:** Rhonda Dunn <rhonda@glenn-law.com>

**To:** Gsullivan4000@aol.com

**CC:** jenniferhopper@fairisaac.com

**References:** 1



EXHIBIT D

Dear Gary,

Attached is the application for your review. You were named as an inventor when we filed the application. Please review the document, and if you have any questions or do not feel you contributed to any of the claims, please let me know,

Thank you and my apologies to you for not including this in my earlier email.

Rhonda




Gsullivan4000@aol.com wrote:

> Rhonda Dunn, On February 27th I sent you email asking for more  
> information with regards to the invention: Method and Apparatus for  
> Creating and Evaluating Strategies. In that email I wrote that the  
> title was too vague for me to relate that to any particular work at  
> Fair Isaac. I still have not heard any more information from you on  
> this matter. You did forward to me two documents: the Assignment and  
> the Declaration for Patent Application, but neither of these documents  
> clarifies the nature of the invention. I hope you can appreciate that  
> before signing these documents I need to have a clear understanding of  
> what is included under "Method and Apparatus for Creating and  
> Evaluating Strategies". Please send me whatever supporting  
> documentation that you can so that I can respond in time for your  
> deadlines. Regards, Gary Sullivan

--  
Rhonda Dunn  
Patent Administrator

Glenn Patent Group  
3475 Edison Way, Suite L  
Menlo Park, CA 94025  
650-474-8400 (Tel)  
650-474-8401 (Fax)  
Rhonda@glenn-law.com

This message is intended only for the individual to whom it is addressed and may contain information that is confidential, privileged, or otherwise exempt from disclosure under applicable law. If you are not the individual to whom this message is addressed, you are advised that any use, copying, or disclosure of this message or the contents thereof is without permission and contrary to law. If you receive this message in error, please call 650-474-8400.

 Assignment.doc	<b>Name:</b> Assignment.doc <b>Type:</b> Microsoft Word Document (application/msword) <b>Encoding:</b> base64 <b>Description:</b> Unknown Document <b>Download Status:</b> Not downloaded with message
 Dec:POA.doc	<b>Name:</b> Dec:POA.doc <b>Type:</b> Microsoft Word Document (application/msword) <b>Encoding:</b> base64 <b>Description:</b> Unknown Document <b>Download Status:</b> Not downloaded with message
 Pat. Appl. final 10.24.03.doc	<b>Name:</b> Pat. Appl. final 10.24.03.doc <b>Type:</b> Microsoft Word Document (application/msword) <b>Encoding:</b> base64 <b>Description:</b> Unknown Document <b>Download Status:</b> Not downloaded with message

**Subject:** ISAA0025 signature forms

**Date:** Wed, 07 Apr 2004 12:29:53 -0700

**From:** Rhonda Dunn <rhonda@glenn-law.com>

**To:** Gary Sullivan <Gsullivan4000@aol.com>, garysullivan@providian.com

**CC:** Julie Thomas <julie@glenn-law.com>, Rhonda <rhonda@glenn-law.com>



EXHIBIT E

Hi Gary,

**RE:** Patent Application Entitled: Method and Apparatus for Creating and Evaluating Strategies

Attached to this email are the application and figures for the above referenced patent application which we filed on behalf of Fair Isaac Corporation on October 29, 2003. Also attached is the Assignment and Declaration forms. Please sign, date, and return the forms to me by April 20, 2004, so that we can file them with the U.S. Patent Office no later than April 20, 2004.

It is important, and necessary, that we receive your original, signed documents for filing with the patent office. We are available to address any concerns or issues you may have. Please contact Julie Thomas, as soon as possible, if you would like to discuss the application and/or the signature forms.

We sincerely appreciate your timely response to this request.





Rhonda

--

Rhonda Dunn  
Patent Administrator

Glenn Patent Group  
3475 Edison Way, Suite L  
Menlo Park, CA 94025  
650-474-8400 (Tel)  
650-474-8401 (Fax)  
Rhonda@glenn-law.com

This message is intended only for the individual to whom it is addressed and may contain information that is confidential, privileged, or otherwise exempt from disclosure under applicable law. If you are not the individual to whom this message is addressed, you are advised that any use, copying, or disclosure of this message or the contents thereof is without permission and contrary to law. If you receive this message in error, please call 650-474-8400.

 Assignment.doc	<b>Name:</b> Assignment.doc <b>Type:</b> Microsoft Word Document (application/msword) <b>Encoding:</b> base64 <b>Description:</b> Unknown Document <b>Download Status:</b> Not downloaded with message
 Dec:POA.doc	<b>Name:</b> Dec:POA.doc <b>Type:</b> Microsoft Word Document (application/msword) <b>Encoding:</b> base64 <b>Description:</b> Unknown Document <b>Download Status:</b> Not downloaded with message
 Pat. Appl. final 10.24.03.doc	<b>Name:</b> Pat. Appl. final 10.24.03.doc <b>Type:</b> Microsoft Word Document (application/msword) <b>Encoding:</b> base64 <b>Description:</b> Unknown Document <b>Download Status:</b> Not downloaded with message
 Formals ISAA0025.pdf	<b>Name:</b> Formals ISAA0025.pdf <b>Type:</b> Portable Document Format (application/pdf) <b>Encoding:</b> base64 <b>Description:</b> Unknown Document <b>Download Status:</b> Not downloaded with message

**Subject:** ISAA0025 Fair Isaac Patent filing  
**Date:** Wed, 28 Apr 2004 11:05:30 -0700  
**From:** Rhonda Dunn <rhonda@glenn-law.com>  
**To:** Gsullivan4000@aol.com  
**CC:** Julie Thomas <julie@glenn-law.com>



**EXHIBIT F**

**References:** 1

Dear Gary,

Previously I had asked that you review the patent application, and sign the declaration and assignment, and return to me for filing with the U. S. Patent Office. In your email, you mentioned that you did not receive the application to review. I have, in other emails, sent the application and figures to you to review. As of today, Julie Thomas and I have made numerous attempts to contact you. You have not returned our emails or phone calls.

Attached again is the patent application, figures, the oath/declaration, and the assignment. If you are agreeable, please sign the forms and fax them to me at 650-474-8401. If I do not hear from you, or receive the forms by Thursday, April 29, 2004, we have no choice but to assume that you refuse to cooperate and sign the declaration for this patent application.

I encourage you to contact Julie if you have any questions or concerns. She will be more than happy to address any of your concerns.

Our filing deadline is Thursday, April 29, 2004.

We look forward to hearing from you, and hope that we can be of assistance to you.

Sincerely,

Rhonda Dunn


Gsullivan4000@aol.com wrote:


> Rhonda Dunn, On February 27th I sent you email asking for more  
 > information with regards to the invention: Method and Apparatus for  
 > Creating and Evaluating Strategies. In that email I wrote that the  
 > title was too vague for me to relate that to any particular work at  
 > Fair Isaac. I still have not heard any more information from you on  
 > this matter. You did forward to me two documents: the Assignment and  
 > the Declaration for Patent Application, but neither of these documents  
 > clarifies the nature of the invention. I hope you can appreciate that  
 > before signing these documents I need to have a clear understanding of  
 > what is included under "Method and Apparatus for Creating and  
 > Evaluating Strategies". Please send me whatever supporting  
 > documentation that you can so that I can respond in time for your  
 > deadlines. Regards, Gary Sullivan


--  
 Rhonda Dunn  
 Patent Administrator

Glenn Patent Group  
 3475 Edison Way, Suite L  
 Menlo Park, CA 94025  
 650-474-8400 (Tel)  
 650-474-8401 (Fax)  
 Rhonda@glenn-law.com

This message is intended only for the individual to whom it is addressed and may contain information that is confidential, privileged, or otherwise exempt from disclosure under applicable law. If you are not the individual to whom this message is addressed, you are advised that any use, copying, or disclosure of this message or the contents thereof is without permission and contrary to law. If you receive this message in error, please call 650-474-8400.

 Assignment.doc	<p><b>Name:</b> Assignment.doc  <b>Type:</b> Microsoft Word Document (application/msword)  <b>Encoding:</b> base64  <b>Description:</b> Unknown Document  <b>Download Status:</b> Not downloaded with message</p>
--	---

 Dec:POA.doc	<p><b>Name:</b> Dec:POA.doc  <b>Type:</b> Microsoft Word Document (application/msword)  <b>Encoding:</b> base64  <b>Description:</b> Unknown Document  <b>Download Status:</b> Not downloaded with message</p>
---	--

 <a href="#">Formals ISAA0025.pdf</a>	<b>Name:</b> Formals ISAA0025.pdf <b>Type:</b> Portable Document Format (application/pdf) <b>Encoding:</b> base64 <b>Description:</b> Unknown Document <b>Download Status:</b> Not downloaded with message
--	--


 <a href="#">Pat. Appl. final 10.24.03.doc</a>	<b>Name:</b> Pat. Appl. final 10.24.03.doc <b>Type:</b> Microsoft Word Document (application/msword) <b>Encoding:</b> base64 <b>Description:</b> Unknown Document <b>Download Status:</b> Not downloaded with message
---	---

EXHIBIT G

Log (ISAA0025)

<b>04/08/04</b>	<i>Follow up w inventor G. Sullivan//Calling him because he has not responded to Rhonda's email of late; He will call me back</i>
<b>04/15/04</b>	<i>Called inventor G. Sullivan//Left detailed msg and again asked that he either call back w questions or sign the forms and return to us</i>

**Subject: Re: ISAA0025 signature forms**

**Date:** Thu, 08 Apr 2004 12:01:18 -0700

**From:** Julie Thomas <[julie@glenn-law.com](mailto:julie@glenn-law.com)>

**Organization:** Glenn Patent Group

**To:** [Rhonda Dunn <Rhonda.Dunn@glenn-law.com>](mailto:Rhonda.Dunn@glenn-law.com)

**References:** 1

Rhonda:

I called him, he couldn't talk at that time, and will call me back.

I'll keep you posted!  
Julie

Rhonda Dunn wrote:

Hi Gary,

RE: Patent Application Entitled: Method and Apparatus for Creating and Evaluating Strategies

Attached to this email are the application and figures for the above referenced patent application which we filed on behalf of Fair Isaac Corporation on October 29, 2003. Also attached is the Assignment and Declaration forms. Please sign, date, and return the forms to me by April 20, 2004, so that we can file them with the U.S. Patent Office no later than April 20, 2004.

It is important, and necessary, that we receive your original, signed documents for filing with the patent office. We are available to address any concerns or issues you may have. Please contact Julie Thomas, as soon as possible, if you would like to discuss the application and/or the signature forms.

We sincerely appreciate your timely response to this request.

Rhonda

--

Rhonda Dunn  
Patent Administrator

Glenn Patent Group  
3475 Edison Way, Suite L  
Menlo Park, CA 94025  
650-474-8400 (Tel)  
650-474-8401 (Fax)  
Rhonda@glenn-law.com

This message is intended only for the individual to whom it is addressed and may contain information that is confidential, privileged, or otherwise exempt from disclosure under applicable law. If you are not the individual to whom this message is addressed, you are advised that any use, copying, or disclosure of this message or the contents thereof is without permission and contrary to law. If you receive this message in error, please call 650-474-8400.

--

Julie Thomas  
Patent Agent

Glenn Patent Group  
3475 Edison Way, Suite L  
Menlo Park, CA 94025

julie@glenn-law.com  
(650) 474-8400 vox  
(650) 474-8401 fax

This message is intended only for the individual to whom it is addressed and may contain information that is confidential, privileged, or otherwise exempt from disclosure under applicable law. If you are not the individual to whom this message is addressed, you are advised that any use, copying, or disclosure of this message or the contents thereof is without permission and contrary to law. If you receive this

message in error, please call 650-474-8400.



Subject: Re: ISAA0025 Gary Sullivan  
Date: Thu, 15 Apr 2004 10:01:52 -0700  
From: [Julie Thomas <julie@glenn-law.com>](mailto:Julie.Thomas@glenn-law.com)  
Organization: Glenn Patent Group  
To: [Rhonda Dunn <rhonda@glenn-law.com>](mailto:Rhonda.Dunn@glenn-law.com)  
References: 1

okay ... I called him and left a detailed message. Hopefully, he will call back or sign and return the forms.

Julie

Rhonda Dunn wrote:


> hi Julie,  
>  
> Any word from Gary? Will he sign the forms?  
>  
> thanks, rhonda

Julie Thomas  
Patent Agent

Glenn Patent Group  
3475 Edison Way, Suite L  
Menlo Park, CA 94025

[julie@glenn-law.com](mailto:julie@glenn-law.com)  
(650) 474-8400 vox  
(650) 474-8401 fax

This message is intended only for the individual to whom it is addressed and may contain information that is confidential, privileged, or otherwise exempt from disclosure under applicable law. If you are not the individual to whom this message is addressed, you are advised that any use, copying, or disclosure of this message or the contents thereof is without permission and contrary to law. If you receive this message in error, please call 650-474-8400.

 **Subject:** Re: ISAA0025 Gary Sullivan  
**Date:** Tue, 20 Apr 2004 10:19:44 -0700  
**From:** Julie Thomas <[julie@glenn-law.com](mailto:julie@glenn-law.com)>  
**Organization:** Glenn Patent Group  
**To:** Rhonda Dunn <[rhonda@glenn-law.com](mailto:rhonda@glenn-law.com)>  
**References:** 1

Rhonda,

I have not heard from him, after two phone calls, one of which I spoke to him personally.

Please send him a final email with you first email attached. Request signatures a final time and give him a deadline (say by end of day Thursday?) that if he does not respond, we will assume his is uncooperative and prepare the papers. CC me. After you CC me, I will follow up with another and final phone call.

Thanks.  
Julie

Rhonda Dunn wrote:

> *Just checking in, any word from Gary or should we treat him as*  
> *unavailable and prepare the petition?*

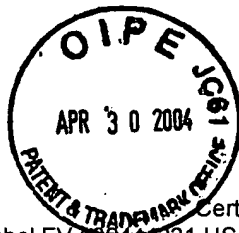
--  
Julie Thomas  
Patent Agent  
Glenn Patent Group

3475 Edison Way, Suite L  
Menlo Park, CA 94025

julie@glenn-law.com  
(650) 474-8400 vox  
(650) 474-8401 fax

This message is intended only for the individual to whom it is addressed and may contain information that is confidential, privileged, or otherwise exempt from disclosure under applicable law. If you are not the individual to whom this message is addressed, you are advised that any use, copying, or disclosure of this message or the contents thereof is without permission and contrary to law. If you receive this message in error, please call 650-474-8400.

10/697,907



Certificate of Transmission Under 37 C.F.R. §1.10  
Express Mail Label EV 18544221 US Date of Deposit: April 30, 2004  
I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to the Commissioner of Patents and Trademarks, Mail Stop Missing Parts, P.O. Box 1450, Alexandria, VA 22313-1450.

Rhonda Dunn  
Rhonda Dunn

## **IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**In re application of:** Caplan, et al.

**Docket No.:** ISAA0025

**Serial No:** 10/697,907

**Art Unit:** 2123

**Filed:** October 29, 2003

**Examiner:** Unknown

**Title:** Method and Apparatus for Creating and Evaluating Strategies

April 30, 2004

Commissioner for Patents  
PO Box 1450  
Alexandria VA 22313-1450

### **PROOF OF REFUSAL TO JOIN BY INVENTORS (37 C.F.R. 1.47)**

Applicant submits herewith the following statement as proof of refusal to join on the part of named inventors Aush Thaker, Nina Shikaloff, and John Perlis. Applicant's attorney of record, Michael A. Glenn, whose signature appears below, sets forth the following statement of facts as the person who presented the inventor with application papers and to whom the refusal was made. The following facts set forth a *bona fide* attempt to present a copy of the application papers, comprising the specification, claims, drawings and the Oath and Declaration, to the non-signing inventors for signature, with the inventors refusing to accept delivery of the papers.

1. The above-named inventors, Aush Thaker, Nina Shikaloff, and John Perlis, are represented by counsel, William M. Scherer.

A series of exchanges between the inventor's counsel and the signatory hereto are attached hereto as Exhibits A through E.

2. During a series of telephone calls made by the signatory below, and conducted with Mr. Scherer, as well as the correspondence reflected in Exhibits A through E, the applicant has made a *bona fide* attempt to present the application herein to the named inventors for review.

3. While correspondence received by applicant from the inventors' attorney, includes statements to the effect that the inventors would be willing to review the application, such statement was never made except in the context of a requirement that the applicant enter into a specific agreement with the inventors with regard to a grant to the inventors of a license under intellectual property rights held by applicant. The placing of such condition on the inventor's cooperation is deemed by applicant to be a constructive refusal to join under 37 C.F.R. 1.47.

4. Nonetheless, on 15 April 2004 (see Exhibit C), applicant provided the inventors' attorney with a complete copy of the patent application and with a declaration. In this letter, the signatory below indicated that applicant is not required to enter into an agreement with regard to applicant's intellectual property as a condition precedent to

the inventors' review of the application. In this letter the inventors were asked to complete review of the application within ten days.

5. Applicant received a letter from the inventor's attorney, dated 19 April 2004, to which was attached a transcription of a voicemail left by the signatory below.

6. Applicant received a letter from the inventor's attorney on 21 April 2004 (see Exhibit E) in which the inventor's attorney indicated that he was "returning the application...unread."

7. Based on the course of correspondence identified above, it is clear that applicant has made a *bona fide* attempt to present a copy of the application papers to the non-signing inventors for signature. It is clear from the course of communications that the inventors, through their attorney, have refused to accept delivery of the papers. Accordingly, applicant has met its obligation under 37 C.F.R. 1.47. The signatory below indicates that such statements were made on the basis of direct knowledge.

I hereby declare that all statements made herein are of my own knowledge, and are true, and that all statements made on information and belief are believed to be true; and further that these statements are made with the knowledge that willful false statements, and the like so made, are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application, any patent issuing thereon, or any patent to which this statement is directed.

This action is necessary to prevent irreparable damage and to preserve the rights of the parties.

The Commissioner is authorized to charge the petition fee forth in 37 C.F.R. 1.17 (i), and any additional fees that may be due and credit any overpayments to Deposit Account No. 07-1445 (Order No. ISAA0025).

Respectfully Submitted,



Michael A. Glenn  
Reg. No. 30,176

Customer No. 22,862



214 Grant Avenue, Suite 400  
San Francisco, CA 94108

EXHIBIT A

Telephone: 415.433.1099  
Facsimile: 415.986.1730

March 26, 2004

**VIA FACSIMILE AND REGULAR MAIL**  
**(650) 474-8401**

Michael A. Glenn, Esq.  
Glenn Patent Group  
3475 Edison Way, #L  
Menlo Park, CA 94025

RE: Patent Prosecution

Dear Mr. Glenn:

This office represents InfoCentricity, Inc., a California corporation ("IC"). I understand that your company represents Fair Isaac Corporation ("FICO"), which wishes to file a patent naming three of its former FICO employees who are now IC employees as the inventors – Aush Thaker, Nina Shikaloff, and John Perlis (the "Employees").

The Employees left FICO as employees in March, 2000, Spring 1999, and August, 2003, respectively. Messrs. Thaker and Perlis continued as contractors for 6 months and approximately one year, respectively, after their employment ended. You have requested that the three execute a patent application as inventors.

You and I spoke on Tuesday afternoon, and you requested IC's position with respect to your request. To make sure there's no misinterpretation of my client's position, I feel it's helpful to respond within the context of this letter.

The short answer is that IC is generally willing to assist FICO if FICO will work with IC to assure that the Employees will not, by agreeing to review the patent application and coming into contact with FICO's confidential information, be viewed as engaging in any activities that give rise to intellectual property, unfair business, or other claims by FICO against the Employees or IC.

As I stated by phone to you, IC is a direct competitor of FICO and it is only appropriate that the two companies work out a procedure for the Employees' review of the patent so that IC's and its Employees' assistance does not by some perverse luck give rise to any FICO claim. You dismissed my concern during our phone call, but my client, as a FICO competitor, does not under any circumstances desire to be considered as acting illegally against FICO's interests. Further, as I state below, the Employees do not know

the scope or purpose of the patent that FICO wishes to file. Therefore, I propose the following:

First, IC will not interfere with the Employees' contractual duty to FICO with respect to your request. I have asked all three Employees to send copies of their employment contracts and understand that Ms. Shikaloff's materials should be in my office at the beginning of the week. Messrs. Thaker and Perlis cannot locate their documentation, and so I request that FICO provide it to me for my review. It is only appropriate that IC understand what obligations its employees have to their former employer.

Second, the Employees and IC on one hand, and FICO on the other, will need to put into place some procedure and agreement so the review will not give rise to any claim against IC or the Employees in the future. I am open to suggestions, but think an initial review by IC's patent counsel at FICO's expense to determine whether the invention is something that the Employees could have invented would be a first step. By doing so, no FICO confidential information would be deemed to have directly or indirectly fallen into IC's hands. An substantive, written agreement that FICO would not view the review as actionable would also be necessary.

I would hope this will be agreeable since you stated during our conversation that you did not believe FICO viewed the Employees' review of the patent in itself to give rise to a claim. Further, IC's assistance will presumably be of benefit to FICO since your client most likely requires an assignment of the invention in the event that any of the Employees have in fact been inventors of the patent.

I also want to clear up any misunderstanding with respect to the timing of this patent application. I attach an e-mail string beginning June 20, 2002, that presumably dealt with this patent application. Mr. Thaker indicated his discomfort in July, 2002, but did not hear about this patent again until February 20, 2004, which e-mail is also attached. I phoned FICO's representatives just six days' later, on February 26<sup>th</sup>, to discuss the points raised in this letter, and it was not until March 23rd during our conversation that IC received a substantive response. IC is willing to assist FICO but requires FICO's assistance.


Finally, I want to state again (as I did in our conversation) that the Employees do not know the scope or context of the patent. You stated during our conversation that the Employees approached FICO with the idea of patenting whatever intellectual property is contained in your documentation a couple of years ago. This is not true. For one thing, Mr. Thaker left FICO nearly 4 years ago. You also stated that there are four inventors, but the e-mail chain indicates substantially more; just that four inventors remain to sign the application. Clearly, your impression that the employees understand what FICO is attempting to patent is mistaken.

Michael Glenn, Esq.  
March 26, 2004  
Page 3 of 3

Nonetheless, the Employees and IC remain open to cooperating with FICO.  
Please call me early next week to discuss putting in place the procedure necessary to carry this forward within the context I outline above. I look forward to your call.

Very truly yours,

SCHERER & SMITH, LLP

A handwritten signature in black ink, appearing to read 'WMS', with a long horizontal line extending to the right.

William M. Scherer

WMS:jvb

Cc: InfoCentricity, Inc.

S:\DOCUMENT\InfoCentricity\Patent\GlennLtr040326.doc

214 Grant Avenue, Suite 400  
San Francisco, CA 94108

EXHIBIT B

Telephone: 415.433.1099  
Facsimile: 415.986.1730

April 9, 2004

Michael A. Glenn, Esq.  
Glenn Patent Group  
3475 Edison Way, #L  
Menlo Park, CA 94025

RE: Telephone Message of April 7, 2004

Dear Mr. Glenn:

I am in receipt of your voicemail of April 7, 2004. In it, you stated that you viewed the fact I wrote a letter, the facts in the letter, and its tone as a constructive refusal of my client to cooperate with Fair Isaac Corporation ("FICO"). You stated that you would be sending a copy of the application to me as InfoCentricity, Inc.'s ("IC") attorney, ask that my client review and sign it if it is their invention, and if they did not sign it within a "reasonable time" you would "proceed in the Patent Office" without any further time required of IC. I take your statement to mean that you would file in the Patent Office a petition to file the application when an inventor refuses to sign.

I do not see how you can view my letter as constituting a constructive refusal of IC or Aush Thaker, Nina Shikaloff, or John Perlis (the "Employees") to cooperate with FICO. Indeed, I stated flatly that IC and the Employees would cooperate with FICO if we could merely determine how to handle two issues:

1. Determine what contractual obligations the Employees have to FICO.  
With respect to this issue, I simply asked that you forward the Employees' employment and related intellectual property agreements to me for review so that we could advise the Employees of their obligations.
2. Determine a method by which the Employees could review the unfiled patent application without creating a situation in which FICO might view IC as having illegally come into contact with FICO's intellectual property.  
I made suggestions in my letter of March 26, 2004, as to how this second issue might be handled, but I do not view them as the exclusive solution to this issue.

Michael Glenn, Esq.  
April 9, 2004  
Page 2 of 2

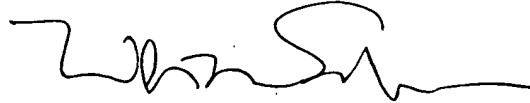
The Employees are willing to meet their obligations to FICO, but it is only reasonable that they understand what those obligations are. Likewise, IC desires the Employees to meet those obligations, but does not wish to inadvertently create rancor between it and a direct competitor. If those two issues can be resolved – and I see no reason why this could not be done – the Employees can determine whether they are in fact the inventors of this FICO patent application.

Therefore, I do not view my proposal as a constructive refusal to cooperate with your office. On the contrary, I view the points you raised in your voicemail to exhibit an unreasonable refusal to consider the legitimate requests of FICO's former employees who now work for its direct competitor.

You may call or write me about this issue. We remain ready to proceed if IC's and the Employees' legitimate needs can be considered. Thank you for your attention to the forgoing.

Very truly yours,

SCHERER & SMITH, LLP

A handwritten signature in black ink, appearing to read 'WMS', with a long horizontal flourish extending to the right.

William M. Scherer

WMS:jmn

EXHIBIT C



April 15, 2004

**VIA FEDERAL EXPRESS #7906-1159-2083**

William Scherer  
Scherer & Smith, LLP  
214 grand Avenue, Suite 400  
San Francisco, CA 94108

Re: Fair Isaac Patent Application for Method and Apparatus for Creating and Evaluating Strategies (Score Tuner and Reporter Software)

GPG Docket No: ISAA0025

Dear Mr. Scherer:

I am in receipt of your letter of 26 March 2004 that does not, in my view, accurately represent the conversation that you and I had. While I am disappointed that it appears from your letter that we will not be able to come to an understanding by which the inventors, John Perlis, Nina Shikaloff, and Aush Thaker ("inventors"), will agree to review the application, I am nonetheless enclosing a copy of the application and declaration power of attorney/assignment therefor in the hopes that they will reconsider their position and sign same.

I also note that my brief voice message asking you to call me to discuss this matter did not result in a return call, but did result in another lengthy letter. You do like to write!


I note in your first letter that you raised various employment issues. These are irrelevant to the issue at hand and I will refer them to Fair Isaac's employment attorneys for resolution.

Your letter demands that Fair Isaac enter into a non-assertion agreement before the inventors will review the application. Fair Isaac is under no obligation to do so. Your clients making this a condition for their review amounts to an affirmative refusal to review the application. There is really nothing to negotiate. Under the patent statutes and regulations they either agree to review the application or they refuse to do so.

Should the inventors not complete review of the application, and sign the enclosed Declaration and Power of Attorney form within ten days of the date of this letter, we will proceed, as I mentioned in my recent telephone calls to you, in accordance with Patent Office procedure and indicate to the Patent Office that they have refused to cooperate in this process. The invention was known by the name "Score Tuner" internally at Fair Isaac. This should assuage any reasonable concerns your clients may have about possible exposure to Fair Isaac trade secrets. They all worked on and are already familiar with this technology. That is why they are named as inventors.

If you can think of any basis for continuing our discussion toward obtaining the inventor's signatures, I am certainly willing to consider your ideas. However, as the facts stand, there can be no other reasonable conclusion but that your clients have refused to review the application and sign the Declaration. Given your penchant for reducing all communications to a crude written record, I suggest that we either communicate only in writing or that you fight the urge to create a (highly inaccurate) record of each conversation we have. If you are amiable to have a conversation that does not resort in a multi-page letter, then do please call me if you like.

Very truly yours,



Michael A. Glenn

MAG/red

Enclosure

214 Grant Avenue, Suite 400  
San Francisco, CA 94108

EXHIBIT D

Telephone: 415.433.1099  
Facsimile: 415.986.1730

April 19, 2004

Michael A. Glenn, Esq.  
Glenn Patent Group  
3475 Edison Way, #L  
Menlo Park, CA 94025

Re: Letter of April 15, 2004

Dear Mr. Glenn:

I am in receipt of your letter, dated April 15, 2004, with the accompanying patent application. I make the following points:

First, I did not phone you after your last voice mail message because I was under the impression that you were not willing to consider any alternative to what I had proposed other than what you now have done; namely, sending the patent application for signature without any precautions with respect to the inventors' obligations to their past and present employers. I attach a transcription of your voice mail, and if I am mistaken, you can let me know. Indeed, I remain interested in coming to an agreement with you so that you can carry out your obligations to your client and I can do the same with mine.

Second, I am unaware of what inaccuracies you believe are contained within my two letters to you. As to your assertion that I have made a "highly inaccurate" "crude written record," I deny that. I can state very honestly that the reason I have communicated to you in writing is because you stated during our first conversation that my clients were refusing to cooperate. My written record is meant to leave no doubt as to my client's true intentions – indeed, that's exactly what I said in my first letter to you. I was concerned that any further conversations we had might be misconstrued by you; perhaps I was correct, since my subsequent written communications have been misconstrued by you.

Third, you state that Fair Isaac Corporation is under no obligation to enter into a "non-assertion agreement," which means my client's request that it do so constitutes an affirmative refusal to review the application. Your logic is patently ridiculous. My client believes Fair Isaac does have an obligation to work out a mutually agreeable solution that meets an inventor's reasonable request to permit him to review the application without fear of repercussions from his former employer. It is your refusal to even consider compromise that has really created this problem.



You also state that the so-called inventors' employment issues are "irrelevant to the issue at hand." How can it be irrelevant when their obligations to Fair Isaac Corporation with respect to the patent application spring directly from their employment contracts?

Finally, you state that if I can "think of any basis for continuing our discussion toward obtaining inventors' signatures, I am certainly willing to consider your ideas." I have grave doubts as to your follow-through based on the (a) attached transcription, (b) statements in your letter (which any reasonable person would view as a rejection of the two concerns I have voiced), and (c) fact you have followed through on your communicated plan to provide the application to me without safeguards.

I request a letter from you which sets forth any compromise you might wish to make that reasonably satisfies the two concerns I have identified. Given the fact you have tendered the patent application to me and unilaterally imposed a 10-day deadline, this is only reasonable to show that you are making a good faith offer. I hope that is your intention and would look forward to a dialogue.

I wish to explore any solution to the two issues that I addressed to you in my two letters. As it is, your mere transmittal of the patent application is nonresponsive.

In the meantime, I will address your letter and timeline with my client and its employees to determine how they wish to proceed. I have not and will not review the tendered application until they have provided feedback.

Very truly yours,

SCHERER & SMITH, LLP

A handwritten signature in black ink, appearing to read 'WMS', with a long horizontal line extending to the right.

William M. Scherer

WMS:jvb

cc: InfoCentricity, Inc.

# Memo

**To:** File  
**From:** Bill Scherer  
**Date:** April 7, 2004  
**Re:** Transcription of Voice Mail Left By Michael Glenn, Esq. to William M. Scherer on  
Wednesday, April 7, 2004

---

Bill, Michael Glenn calling. I've been out of the office, I know you returned my call earlier this week and um, give me a call later today if you will, (650) 474-8400. Just to get you started, I've looked at your letter and I'm surprised you even wrote a letter. I thought we were just going to try to have an amicable discussion and see if we couldn't work this small issue out without any further expense or effort but since you produced the letter and the letter has from my point of view some inaccuracies and incorrect statements, um, its going to be difficult for us to work in any amicable way, and I take your letter to mean to amount to a constructive refusal on the part of your client. So, what I'm going to do, and we can discuss this but, what I'm going to do is, I'm going to send a copy of the application to you as their attorney, with the forms and ask that they review it and read it and ahh, and sign the declaration if its their invention. Ah, if they do that then that's fine, however, if we don't within a reasonable period of time hear from you that you intend to have it signed then we'll take it as a no and we'll just proceed in the Patent Office without taking any more time or effort from your clients. So let's just close the loop on this today and maybe you have some other ideas I'm certainly interested in hearing them. I just don't see given your letter and the tone of your letter and the statements how we're going to come to any kind of an agreement outside of just doing it through the Patent Office procedure. Talk to you later.

S:\DOCUMENT\InfoCentricity\Patent\Glenn VoiceMailofApril7,2004.doc

# SCHERER & SMITH LLP

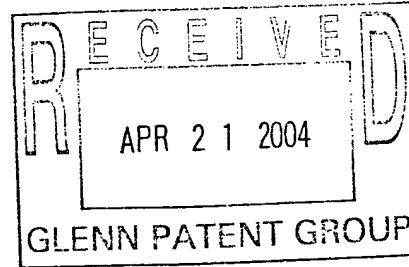
EXHIBIT E

214 Grant Avenue, Suite 400  
San Francisco, CA 94108

Telephone: 415.433.1099  
Facsimile: 415.986.1730

April 21, 2004

Michael A. Glenn, Esq.  
Glenn Patent Group  
3475 Edison Way, #L  
Menlo Park, CA 94025



Re: Patent Application

Dear Mr. Glenn:

I have spoken to my client and its employees and they remain concerned about their review of the patent application due to the issues I have addressed to you. If we can find a way to reasonably deal with these two issues I believe their review of the application can occur. Please call or write me with any compromise suggestions you might have in order to get this task completed.

In the meantime I am returning the patent application to you unread.

I look forward to your feedback.

Very truly yours,

SCHERER & SMITH, LLP



William M. Scherer

WMS:jvb

cc: InfoCentricity, Inc. (w/o enclosures)

\\Scherersmith01\Company\DOCUMENT\InfoCentricity\Patent\GlennLtr040420.doc